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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,879	08/17/2000	Toshiyuki Shibuya	A243-1	5305

21254 7590 06/18/2003  
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VIENNA, VA 22182-3817

EXAMINER

KISS, ERIC B

ART UNIT	PAPER NUMBER
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2122

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DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/639,879		SHIBUYA, TOSHIYUKI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Eric B. Kiss		2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3 and 5 &amp; 2</u> | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Claims 1-33 have been examined.

#### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on August 17, 1999. It is noted, however, that applicant has not filed a certified copy of the 11-230616 application as required by 35 U.S.C. 119(b).

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "said memory" in line 5. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the preceding limitation "storing a plurality of programs..." is subsequently interpreted as "storing, in a memory, a plurality of programs..." for the purpose of further examination.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,848,064 to Cowan.

As per claims 1, 4, and 32, Cowan discloses a portable terminal device (mobile terminal) comprising a memory storing therein at least two programs grouped into at least two groups with respect to a function of a program (see column 1, lines 48-57; and column 7, lines 13-31); and a management table which stores first data about whether each of said programs is used or not (see column 7, lines 37-50; and column 12, lines 49-52), and removes a non-used program from said memory (see, for example, column 12, lines 49-55).

As per claim 2, Cowan further discloses the memory receiving only a necessary program from a program-transferring device, in accordance with said first data (see column 13, lines 15-46).

As per claim 3, Cowan further discloses a first device to carry out a program, said first device causing said memory to boot a used program to said first device with reference to said first data, if a check sum of said memory is not coincident with a check sum of said first device,

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and copying programs stored in said first device into said memory (see Fig. 8(b); and column 12, lines 60 through column 13 line 46; the mobile terminal, as part of a boot-up process has its stored version information compared with that stored in the host computer, and updates are performed if necessary).

As per claims 5 and 14, Cowan discloses a portable terminal device (mobile terminal) comprising memory storing therein a main program and an application program (see column 7, lines 13-36) and data about the main and application programs in the form of a table (see, for example, column 8, lines 19-32; and column 12, lines 15-28); a signal receiving/transmitting circuit and a central processing unit (see Fig. 2).

As per claim 6, Cowan further discloses storing data about whether the main program and application program is used or not (see, for example, column 8, lines 19-32; column 12, lines 15-28; and column 14, lines 50-61).

As per claims 7 and 27, Cowan further discloses package definition files including a program ID of each program (file name), a flag indicating whether each program is used or not (a user selection); a packet number and final packet number transferred from the program-transferring device (see, for example, column 13, lines 54-65); an initial address (mobile terminal path and host path); and a program length (memory required; see Figs. 5a through 5d; column 11, lines 24-35; and column 14, line 62 through column 15, line 9).

As per claims 8 and 9, see the disclosure applied above to claims 2 and 3, respectively.

As per claims 10-12, Cowan further discloses the memory comprising an EEPROM portion (see column 7, lines 15-19) and a RAM portion (see column 9, lines 12-15).

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As per claim 13, the connection of a power source to the RAM in Cowan is implied as files are transferred to and stored in the RAM (see column 9, lines 12-15).

As per claims 15 and 22, in addition to the disclosure applied above to claims 1 and 5, Cowan further discloses a base station and a program-transferring device (host; see Fig. 1).

As per claims 16, 19, 21, 23, 26, 28, 29, and 31, see the disclosure applied above to claims 2-4 and 6.

As per claims 17, 18, 24, and 25, Cowan uses an IP address associated with each mobile terminal to encode transmissions (see, for example, column 8, lines 25-32).

As per claims 20 and 30, Cowan further discloses the program-transferring device comprising a memory storing a program, a encoding/transferring circuit, and a controller circuit (see Fig. 3).

As per claim 33, see the disclosure applied above to claims 3 and 5.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The examiner can also be reached on alternate Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 308-4789.

**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O.Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(703) 746-7239 (for formal communications intended for entry)

**Or:**

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

EBK/EBK  
June 6, 2003



**TUAN Q. DAM  
PRIMARY EXAMINER**